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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,204	11/22/2000	Sam B. Morrison	05725.0642-00	9514

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
1300 I STREET, NW  
WASHINGTON, DC 20005

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/717,204	<b>Applicant(s)</b> MORRISON, SAM B.	
	<b>Examiner</b> Shengjun Wang	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-26,32 and 33 is/are allowed.
- 6) ☒ Claim(s) 27-29,31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 26, 2004 has been entered.

### *Claim Rejections 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 27-29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deslauriers (US 5,221,534, of record), in view of Anton (US 6,063,313, of record), Konik (US 6,060,072, of record) or Kimura (US 4,528,390, of record), and in further view of Mougin et al (US 5,945,095) for the employment of powder in cosmetic composition.

3. Deslauriers teaches a healthy and beauty aid compositions comprising a gel made from blends of di- and triblock copolymers. The gels provide an excellent media or vehicle for delivery of beauty aids (such as mineral oil) to the skin (see, col. 3, lines 7-23). The preferred polymers include those employed herein, e.g., KRATON series of copolymers G1652 (SEBS type). See, particularly, columns 4-5, and column 9, lines 50-68. silicone may be used as solvent of the triblock polymer containing composition. See, column 6, lines 34-40. dimethicone and

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cyclomethicone are known to be useful with the polymers. See, particularly, table 11 and 17. The health and beauty aid composition may be essentially incorporated with any beauty and health aid ingredients and in various forms, such as makeup, mascara, makeup foundation, etc, which are well-known in the art to comprise powder components. See, particularly, column 6, line 64 to column 7, line 45. The composition may comprise 1-20% of a blend of polymer, 5 to 95% of which is triblock polymer. See, particularly, the claims.

4. Deslauriers does not teach expressly the employment of dimethicone, particularly, in the percentage as recited herein, or the particularly amount of triblock polymer herein, or the other particular cosmetic ingredients recited herein.

5. However, Anton teaches the use of volatile silicones (linear and cyclic) with 9 or fewer silicon atoms as volatile solvent in cosmetics. The oils include hexamethyldisiloxane (see, column 4, line 4 to col. 5, lines 13). The volatile oils enable easy formulation and leave the non-volatile ingredient on the skin (col. 4, lines 35 –53). Konik teaches the use of film forming agents in transfer resistant cosmetic composition. Konik teaches that the film-forming agent provides water-proofing properties, improve the wear of the composition, and conferr transfer-resistance to the makeup product (see col. 2, lines 17-34). Trimethylsiloxysilicate and polyethylenepolymers are taught as a useful film forming agent. Kimura teaches the preparation of polymethylsilsequioxanes. The title compounds are taught as useful anti-caking agents for powder products and as additive for cosmetics (see col. 3, lines 1-31)

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a cosmetic composition based on the composition disclosed by Deslauriers comprising the particular amounts of the triblock polymer,

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the particular dimethicone and the other well-known cosmetic ingredients, such as powders, other film forming agents, and sun screen agents.

A person of ordinary skill in the art would have been motivated to make a cosmetic composition based on the composition disclosed by Deslauriers comprising the particular amounts of the triblock polymer, the particular dimethicone and the other well-known cosmetic ingredients, such as powders, other film forming agents, and sun screen agents because the amount of triblock polymer is within the range disclosed by Deslauriers; Deslauriers' composition is known to be various cosmetic compositions. Further, it would have been obvious to one of ordinary skill in the art to have formulate the composition of Deslauriers by the incorporation the volatile silicones for the ease of formulation imparted by the silicones as taught by Anton, by the addition of trimethylsiloxysilicate and polyethylene polymers for the improved properties of the film-forming agents as taught by Konik, or by the incorporation of polymethylsilsesquioxanes for their anti-caking properties in cosmetic as taught by Kimura. Note in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art," (as in the case of the amount of triblock polymer herein) a prima facie case of obviousness exists. In *re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In *re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); In *re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). As to the employment of powders in cosmetic composition, note it is well known in the art that powders are routinely incorporated in to cosmetic compositions such as mascara, makeup foundation. For example, Mougin discloses mascara composition comprising polymeric particles, such as polyethylene. See particularly, column 9, lines 4-65, the example 7, and the claims. Finally, the optimization of a result effective parameter, e.g., eh amounts of

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known cosmetic agents in a cosmetic composition, is considered within the skill of the artisan.

See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

***Response to the Arguments***

Applicants' amendments and remarks submitted May 26, 2004 have been fully considered, and are found mostly persuasive. Particularly, Deslauriers discloses the incompatibility of block polymer and dimethicone (linear dimethicone) at certain concentration. However, applicants show that at the particular concentrations of the block polymer and dimethicone herein claimed, good compatibility was obtained.

Claims 27-29 and 31 are properly rejected as they do not cite the limitation of the particular amounts of block polymer and dimethicone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**SHENGJUN WANG**  
**PRIMARY EXAMINER**

Shengjun Wang  
Primary Examiner  
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